

REMARKS

The application has been reviewed in light of the July 2, 2003 Office Action. Claims 2-21 are pending in the application. Claims 4, 6, 7, 9, and 10 have been amended to correct their dependency from claim 1 to claim 3. Claim 17 has been amended to correct the typographical error.

Claims 1-10 and 14-21 were rejected under the judicially created doctrine of obviousness-type double patenting in view of the parent of the present application, namely, U.S. Patent No. 6,319,266. A terminal disclaimer accompanies the present amendment and is believed to overcome the outstanding rejection.

In the Office Action, claims 1-19 and 21 were rejected under 35 U.S.C. §102(b) in view of U.S. Pat. No. 5,868,773 (Danks et al.) As an initial matter, claim 1 has been previously canceled so the rejection as pertains to claim 1 is believed to refer to Claim 3.

Applicants respectfully traverses the rejection in view of Danks et al.

With regard to independent claim 3, the Office Action fails to identify any disclosure in the Danks et al. patent which teaches or suggests an obturator assembly of a trocar system, wherein the obturator assembly includes a release member having a button portion and a camming surface; wherein the button portion protrudes at least partially through an opening formed in a distally facing end surface of an obturator housing, as recited in claim 3 of the present application.

The Office Action dated July 2, 2003, still fails to identify the disclosure in the Danks et al. patent of each and every limitation of claim 3 from which claims 2-13 now depend.

The Office Action at paragraph 7 states:

[t]he applicant argues language not in the claims. The language that is not in the claims is wherein the button is mounted on the obturator housing. The examiner is interpreting the claim to read wherein the button protrudes through the housing, there is no mention of the button being directly mounted to the obturator housing, therefore the examiner is unclear as to the argument the applicant is making. The obturator housing is reference number 40; therefore the button does protrude through the housing.

Applicants respectfully disagree with the above-noted characterization of Applicants remarks submitted in either the amendment dated December 16, 2002 which addressed independent claims 3 and 11, or in the Supplemental Amendment dated April 10, 2003, which addressed independent claim 14 (which the Office Action refers to as “Applicants arguments filed 4/21/03”).

Further, the above quoted section from the office action indicates that the Examiner is interpreting the claims to read “wherein the button portion protrudes though the housing”. As for claim 3, the Office Action goes on to state that, in Danks, “[t]he obturator housing is reference number 40; therefore the button does protrude through the housing”.

However, this reference to the Danks et al. patent disclosure does not disclose or suggest the elements of claim 3. In particular, claim 3 recites “the button portion protrudes at least partially through an opening formed in the distally facing end surface of the obturator housing”. The reference number 40 (referred to as “outer housing” in Danks et al.) pointed out in the Office Action, refers to a cannula housing in each of the embodiments of the Danks et al. patent disclosure and not an obturator housing. The button portion as recited in claim 3 extends at least partially through a distally facing end surface of the obturator housing.

Accordingly, for the above reasons and those previously set forth in the amendments dated December 11, 2002 and April 10, 2003, claim 3 and claims 2-10 which depend therefrom are believed to patentably distinguish over the Danks et al. patent.

Applicants respectfully point out that the two prior amendments do not state that any of the claims recite that the button is mounted on the housing. Rather, Applicants remarks point out that claim 3 recites a release member having a button portion that protrudes at least partially through an opening in the obturator housing. It is Applicants' undersigned representative's belief that the Examiner has misread the remarks in the prior Amendments.

With regard to independent method claim 11 and claims 12-13 which depend therefrom, the Office Action states that:

since no orientation or direction is specified in the claims, the examiner determines that the release member [presumably of Danks et al. although no structure is specified in the Office Action] does move in a proximally [sic] direction depending on the orientation at which the trocar is held.

Applicants respectfully disagree with this assessment of claim 11, as the term proximally is used twice in the recitations of claim 11. The first instance is as follows: "approximating an obturator assembly with a cannula assembly such that a button portion of a release member is urged proximally". The second instance states: "inserting the trocar assembly through the body wall of a patient by pushing the trocar assembly toward the body wall such that a guard of the shield is urged proximally. ..." Thus, both the button portion of a release member and a guard shield move in the same relative direction relative, *i.e.*, "proximally" as recited in claim 11.

As previously set forth in the remarks submitted with the December 11, 2002 amendment:

The Danks et al. patent disclosure requires that:

In order to permit the shield 15 to be retracted [*i.e.* moved proximally], the latch means 33 must first be armed or actuated. In the embodiment illustrated in FIG. 2A, the distal end 22 of the linking member 24 engages with a trigger 48. When the trigger 48 is depressed and pushed forward toward the piercing tip 80 [*i.e.* distally], the linking member 24 is likewise pulled forward.

(Col. 4, l. 50-55. Emphasis added.)

Thus, as recited in claim 11, the button portion of the release member is moved in exactly the opposite direction as the trigger 48 of the Danks et al. patent. Accordingly, reconsideration and withdrawal of the rejection as pertains to claims 11-13 is respectfully requested.

Claims 14-19 and 21 were rejected under 35 U.S.C. §102(b) in view of U.S. Pat. No. 5,904,699 (Schwemberger et al.)

Applicants respectfully traverse the rejection in view of Schwemberger et al. The trocar disclosed in the Schwemberger et al. patent has a shield 56 which is manually moved proximally to expose a flat cutting blade 61 by “precocking” the instrument with a precock lever 52 that is pivotally mounted in the obturator handle 51. As noted in the abstract of the Schwemberger et al. patent, “[p]recocking the trocar moves the shield from the distal position wherein the flat blade is covered, to a proximal position wherein the flat blade is exposed, and the shield is constrained by the shield retaining assembly.”

Claim 14, in contrast to the Schwemberger et al. patent disclosure, recites in part, an obturator assembly having a latch mechanism which facilitates changing the configuration of the obturator assembly wherein at least a portion of the guard is maintained to extend at least partially distally of a penetrating tip to a non-fixed shield orientation whereby upon application

of force to the distal end of the obturator assembly, the guard and penetrating tip are permitted to move relative to one another to facilitate puncturing tissue.

Thus, the precocking manipulation as disclosed in Schwemberger et al. expressly teaches structure and function wherein prior to contact with tissue (*i.e.* application of a force to the distal end of the obturator assembly) the guard is physically moved to expose a flat knife. The Schwemberger et al. patent does not disclose or suggest the trocar system of claim 14 which recites a latch mechanism that facilitates changing the configuration of an obturator assembly to a configuration where a guard is permitted to move relative to a penetrating tip upon application of force to the distal end of the obturator assembly.

Accordingly, claim 14 and claims 15-21 which depend therefrom are believed to patentably distinguish over the Schwemberger et al. patent. Reconsideration and withdrawal of the rejection are respectfully requested.

In view of the above remarks and those submitted with the responses dated December 11, 2002 and April 10, 2003 (referred to in the July 2, 2003 Office Action as "Applicant's arguments filed 4/21/03"), each of the pending claims 2-21 are believed to be allowable over the art of record. Therefore, reconsideration and withdrawal of the outstanding rejections are respectfully requested. Should the Examiner believe that a telephone or a personal interview may help clear up any misunderstanding of Applicants previously submitted remarks or facilitate resolution of

any remaining matters, he is respectfully requested to telephone Applicant's undersigned representative at the number indicated below.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Raymond E. Farrell", written in a cursive style.

Raymond E. Farrell
Reg. No. 34,816
Attorney for Applicants

CARTER, DeLUCA, FARRELL & SCHMIDT, LLP
445 Broad Hollow Road
Suite 225
Melville, New York 11747
Phone: (631) 501-5700
Fax: (631) 501-3526

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